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10/822,363

04/12/2004

Christopher Ronnewinkel

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EXAMINER

HWANG, JOON H

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/822,363 | Applicant(s) RONNEWINKEL ET AL. | |
| | Examiner Joon H. Hwang | Art Unit 2166 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The claims 1-18 are pending.

Claim Objections

2. Claims 1, 5, 8, and 16-18 are objected to because of the following informalities:
 - “the selected” in 8th line of claim 1 should be “a selected”;
 - “the suggested” in 2nd line of claim 5 should be “a suggested”;
 - “that” in 2nd line of claim 8 is not clear, thus needs to be specified;
 - “the selected” in 10th line of claim 16 should be “a selected”;
 - “the content” in 3rd line of claim 17 should be “a content”; and
 - “the first and second” in 1st line of claim 18 should be “the email editor and the ERMS”.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 5-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 merely reciting analyzing and executing modules does not produce a “useful, concrete and tangible” result, thus claim 1 is non-statutory. See MPEP 2106 (II)(A). Claims 5-17 are likewise rejected. “A

computer program product tangibly embodied in an information carrier” in 1st line of claim 16 is insufficient to render the claim fallen within a statutory category since “an information carrier” is not clearly limited to physical articles or objects, such as a storage device disclosed on pages 40-41 of the specification. Thus, claim 16 is non-statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 and 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ronnewinkel et al. (U.S. Publication No. 2004/0083191).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Ronnewinkel teaches responding to a received message (abstract and fig. 5). Ronnewinkel teaches analyzing content of a received message to

select which of a plurality of predefined categories relates to the received message, each predefined category having response information linked thereto (abstract, fig. 5, sections 6-11 on page 1, sections 22-23 on page 2, and sections 31-32 on page 3). Ronnewinkel teaches if a first of a plurality of predefined computer-executable response modules is executed, executing the first module using at least a first part of the response information linked to the selected category (fig. 5 and sections 31-32 on page 3). Ronnewinkel teaches if a second of the plurality of predefined computer-executable response modules is executed, executing the second module using at least a second part of the response information linked to the selected category (fig. 5, sections 6-14 on page 1, sections 33-36 on page 3, and section 57 on page 4).

With respect to claim 2, Ronnewinkel teaches displaying suggested response message content on a display device, the suggested content being included in the linked response information (fig. 3, fig. 4, and sections 31-36 on page 3).

With respect to claim 3, Ronnewinkel teaches the suggested content includes at least one document (fig. 3, fig. 4, section 22 on page 2, and sections 31-36 on page 3).

With respect to claim 4, Ronnewinkel teaches the suggested content includes at least one response template (fig. 3, fig. 4, section 22 on page 2, and sections 31-36 on page 3).

With respect to claim 5, Ronnewinkel teaches receiving user commands to send a response message with the suggested content (fig. 3, fig. 4, section 22 on page 2, and sections 31-36 on page 3).

With respect to claim 6, Ronnewinkel teaches executing a message routing instruction that routes the received electronic message to a user's email account, the message routing instruction being included in the linked response information (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 7, Ronnewinkel teaches executing a message routing instruction that routes the received electronic message to a user's incoming electronic message account, the message routing instruction being included in the linked response information (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 8, Ronnewinkel teaches the user's incoming electronic message account is that of an expert (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 9, Ronnewinkel teaches the first module is one that produces a response message, and the second module is one that executes a procedure other than producing a response message (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 10, Ronnewinkel teaches the first part is an auto-response (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 11, Ronnewinkel teaches the first part involves suggested content (fig. 4, fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 12, Ronnewinkel teaches the other procedure is service related (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 14, Ronnewinkel teaches the first and second parts of the linked response information are different (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

With respect to claim 15, Ronnewinkel teaches the received message comprises an email (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3, and section 57 on page 4).

The limitations of claim 16 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

With respect to claim 17, Ronnewinkel teaches receiving an email, the content of which relates to one of a plurality of predetermined categories in a categorization scheme, each predetermined category having business objects linked thereto (abstract, fig. 5, sections 6-14 on page 1, and sections 22-23 on page 2). Ronnewinkel teaches selecting a category from among the plurality of predetermined categories (sections 6-14 on page 1 and sections 31-36 on page 3). Ronnewinkel teaches receiving user input that identifies which of a plurality of response procedure modules are to be executed in response to the received email (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3). Ronnewinkel teaches if an email editor module is executed, using a response template selected from among the business objects linked to the selected category (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3). Ronnewinkel teaches if an

ERMS module is executed, suggesting at least one business object linked to the selected category, the suggested business object including at least one of a quick solution document and an expert selected from among the business objects linked to the selected category (fig. 5, sections 6-14 on page 1, sections 31-36 on page 3).

With respect to claim 18, Ronnewinkel teaches executing one of the first and second modules involves displaying suggested response message content on a display device, the suggested content being included in the linked response information (fig. 4, fig. 5, sections 6-14 on page 1, sections 31-36 on page 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being obvious over Ronnewinkel et al. (U.S. Publication No. 2004/0083191) in view of Haigh (U.S. Patent No. 5,793,861).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

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invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

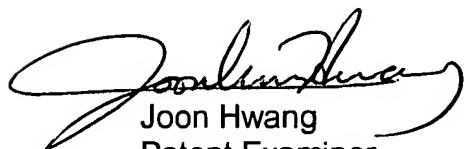
With respect to claim 13, Ronnewinkel discloses the claimed subject matter as discussed above except the service-related procedure involves scheduling a service order. However, Haigh teaches the service-related procedure involves scheduling a service order (fig. 2, fig. 6, and lines 25-40 in col. 7) in order to handle a business transaction. Therefore, based on Ronnewinkel in view of Haigh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Haigh to the system of Ronnewinkel in order to handle a business transaction.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M~F).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Joon Hwang', is written over a horizontal line.

Joon Hwang
Patent Examiner
Technology Center 2100

9/25/06